REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed on August 28, 2009. Through this response, no claims have been amended, and claim 116 has been added. Reconsideration and allowance of the application and pending claims 1-16, 20-25, 27-65, 69-97, and 112-116 are respectfully requested.

I. Claim Rejections under 35 U.S.C. §103(a)

A. Statement of the Rejection

1. Claims 1-16, 20-24, 27-45, 49-65, 69-73, 75-94 and 112-115 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 7,096,486 to *Ukai et al.* ("*Ukai*") in view of U.S. Patent No. 5,758,257 to *Herz et al.* ("*Herz*").

2. Claims 25 and 74 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ukai* in view of U.S. Patent No. 6,177,931 to *Alexander et al.* ("*Alexander*").

3. Claims 46-48 and 95-97 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ukai* in view of U.S. Patent No. 6,675,384 to *Block et al.* ("*Block*").

Applicant respectfully traverses these rejections.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

(A) Determining the scope and contents of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art; and

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(D)   Evaluating evidence of secondary considerations.

Applicant respectfully submits that a *prima facie* case of obviousness is not established

using the art of record.

1.   Claims 1-16, 20-24, 27-45, 49-65, 69-73, 75-94 and 112-115 - 35 U.S.C. § 103(a) – *Ukai*

and *Herz*

A.   Independent Claim 1

Claim 1 recites (emphasis added):

1. A method for providing television functionality comprising:
        tracking a plurality of viewing parameters corresponding to services that
are provided to a user;
        determining a user preference for each of the plurality of viewing
parameters;
        tracking the user preference by assigning a score to each of the plurality
of viewing parameters;
        weighting the scores;
        ***determining an overall user preference score for the plurality of
tracked viewing parameters based on a linear combination of the
weighted scores associated with each of the plurality of tracked viewing
parameters for the user***;
        receiving user input requesting television functionality; and
        providing the user with a result that is responsive to the user input and to
the overall user preference score.

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that a

prima face case of obviousness has not been established based on *Ukai* in view of *Herz*. The

non-final Office Action (page 4, emphasis in original) acknowledges that "Ukai fails to teach

weighting each of the viewing parameters and determining an overall user preference score for the

plurality of tracked viewing parameters based on a linear combination of the weighted scores

associated with each of the plurality of tracked viewing parameters for the user," yet alleges the

following on pages 4-5 (emphasis in original):

        Herz also discloses assigning scores to viewing parameters **(see Column
**11, Line 30 through Column 15, Line 43 for creating and adjusting scores of
characteristic values in customer profiles)** and weighting the scores **(see
Column 10, Lines 39-40, Column 11, Lines 16-29 and Column 13, Lines 40-54).**

Herz further teaches determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user **(see Column 19, Line 5 through Column 21, Line 62 for using the weighted scores to determine a overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores in the customer profiles associated with each of the tracked characteristics for the user).** *The Examiner further notes Column 29, Line 29 through Column 34, Line 11 for how customer profile characteristics values are continually updated based on the passive viewing of television program by a user, which includes additionally weighting the scores.*

Applicant respectfully disagrees. From the above, it appears that the Office alleges that the "characteristics" equate to the claimed *viewing parameters*. Assuming *arguendo* that alleged equivalence to be valid, it remains a bit unclear what is intended as the scores. The reason for the unclarity is that the citations to *Herz* referenced above describe both cv and cp values. However, cv is described in col. 10, line 33 of *Herz* as the customer's rating of a characteristics, and explains in lines 47-58 of col. 10 (*Herz*) that the value or, apparently, alleged "score" of cv equates to the accepted or preferred level for characteristic k. The above-citations particularly point to col. 10, lines 48-49 of *Herz* (among other sections for weighting), where weighting involves the customer's weight, wv, of a characteristic, and cp, which is described in col. 10, line 39 of *Herz* as the objective weighting of program j for characteristic k. For the sake of advancing a discussion on the merits, it is assumed *arguendo* that the value of cv is intended as an equivalent to the claimed *score*, and that w is intended as an equivalent to the claimed *weighting* of the intended score. Wv is described in col. 11, lines 15-17 of *Herz* as illustrating the importance of characteristic k to the customer. So, it appears that the weighting and cv value are intended to enable (through inclusion in the agreement scalar) the system in *Herz* to determine what characteristics are important and acceptable to a user and hence facilitate the decision as to which program to include in a virtual channel (see, for example, column 9, lines 30-52, *Herz*). In other words, without using another methodology, such as duration of viewing (e.g., *Ukai*), as a method to determine importance of characteristics to the customer, the Cv and weighting values appear to be critical in *Herz* to

establishing relevance and importance. On the other hand, *Ukai* enables the determination of which programs are preferred based on amount of time of viewing (duration) and the consequential generation of scores based on the duration of viewing (e.g., to establish the program view measure, which is used as a basis for all further calculations to result in a value in the database 300 (see, element 313, Figure 3 of *Ukai* and the previous response discussion). Weighting is shown in Figure 7 of *Ukai* for only one (element 703) of the plural characteristics that go into the final preference tally (total view score, 714, Figure 7, *Ukai*), suggesting less importance to the overall score than that which is attributed to weighting in *Herz*. Indeed, there exists no explanation as to the purpose of the weighting in *Ukai*, also suggesting a less significant role in the overall determination of preference measures, and more importantly, a fundamentally different methodology as explained further below.

Continuing, columns 19-21 of *Herz* illustrate an example of customer and content profiles, and the calculation of an agreement scalar between a given customer and program and ultimately a final agreement matrix. From col. 21, lines 50-52 of *Herz*, there appears to be a formula that involves a summation of weighting values multiplied respectively by the difference between cv and cp for each of the plural characteristics. Col. 10, lines 34-56 of *Herz* notes that an agreement scalar represents the similarity between the vector customer profile corresponding to cv and the vector program profile corresponding to cp, and col. 19, lines 5-10 of *Herz* indicates that the agreement scalars form an agreement matrix which provides measurements of the similarity between customer profiles and content profiles. A further explanation of an agreement matrix is provided in col. 19, lines 59-65 of *Herz*, which provides as follows:

> In other words, perfect agreement will be met only when there is no difference between the customer profile and the content profile, or when there are differences only on certain characteristics and the customer ignores those characteristics. As a result, sorting all the programs in the ascending order of ac renders a recommendation list of programs for the customer.

Assuming *arguendo* the agreement matrix to be equivalent to the claimed **overall user preference score**, it is clear that the matrix provides an indication of similarity in characteristics between the customer profile and the content profile for a program, whereas *Ukai* uses duration of viewing as an underlying basis for a match between what characteristic is desired or preferred by a viewer and whether a given program has the desired characteristic. Perhaps the best that can be said of *Herz* is that the frequency of viewing may be used for determining relevance (e.g., in an update or feedback mode, such as described in col. 25, lines 38-40, col. 31, line 45, col. 33, line 62, col. 38, lines 58-60, *Herz*), which is clearly not the same as duration as described in *Ukai*.

In view of the above-discussion and these fundamental differences, one question to be asked in general is whether it is indeed obvious to combine *Ukai* and *Herz*, and in particular, whether one having ordinary skill in the art would be motivated to combine *Ukai* and *Herz*. The non-final Office Action (page 5) offers the following justification for combining *Ukai* and *Herz* (emphasis in original):

> At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the preference determination system, as taught by Ukai, using the agreement matrix calculation technique, as taught by Herz, for the purpose of providing video programs that have the most appeal to the customer **(see Column 9, Lines 50-51 of Herz).**

Applicant respectfully disagrees with this alleged motivation. For instance, as explained above, weighting appears more critical to *Herz* than to *Ukai*. Indeed, weighting in the manner described by *Herz* (e.g., for each and every characteristic) would fundamentally alter the operation of *Ukai*, which weights only one element (see Figure 7, element 703, *Ukai*) in its computation of a final or total view score. As set forth according to well-established Federal case law (and reproduced in MPEP 2143.01):

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Additionally, the system described in *Ukai* already chooses programs with the most appeal based on scoring and the underlying duration of viewing as the basis of the scoring. It is not technically prudent to alter the system of *Ukai* to achieve that which it already performs without the modification. Indeed, the emphasis on test groups and heavy customer interaction pertaining to the development of pre-configured customer and content profiles in *Herz* suggests an inferior process to the automation-focused system described in *Ukai*, further dissuading one having ordinary skill in the art to seek to modify *Ukai* in view of *Hertz*. For at least these reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been established, and respectfully requests that the rejection be withdrawn and claim 1 allowed.

Since independent claim 1 is allowable, Applicant respectfully submits that claims 2-16, 20-24, and 27-45, and 112-113 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988).

Applicant further notes that several dependent claim rejections had been rebutted in the previous response with no response or consideration of these arguments proffered in the present non-final Office Action. Though acknowledging the changed grounds of rejection compared to the previous response, it is noted that the language of the rejection for the below dependent claims remain un-altered from the previous rejection, hence suggesting no consideration. Accordingly, Applicant repeats and reproduces below (with minor changes to clarify which non-final Office Action is referenced) for consideration these rebuttal arguments and respectfully requests consideration of the same.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 3 and 4 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 3 and 4. Specifically, Applicant's claims 3 and 4 provide as follows (emphasis added):

3.   The method of claim 1, where ***the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user***.

4.   The method of claim 1, where **the user preference is determined based on** a duration and **a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user**.

The previous non-final Office Action (page 8), like the final rejection (pages 4-5), alleges that "Ukai discloses that the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user (**see Figure 6 for determining a user preference 604 based on a number of programs 603 viewed**)" (emphasis in original). Applicant respectfully submits that "a frequency that a service … is presented to the user" is not the same as a number of programs viewed. Frequency implies a per-time period basis, which *Ukai* fails to teach.

Further, the previous non-final Office Action (page 9) refers to the rejection of claims 2 and 3 on page 8) for alleged support in *Ukai* for anticipation of the above-emphasized claim features. The rejection appears to allege that based on 404 (view time period) and 604 (specific view score), the above-emphasized features are shown. Applicant respectfully disagrees, and notes that *Ukai* does not teach or suggest that view time period 404 is determined based on "a frequency that a service … is presented to the user" as recited in claims 3 and 4. Again, frequency implies a per time period basis that is absent in *Ukai*.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 3 and 4. Therefore, Applicant respectfully requests that the rejections of claims 3 and 4 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claim 6 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claim 6. Specifically, Applicant's claim 6 provides as follows (emphasis added):

6.   The method of claim 1, where **the user preference conflicts with another user preference**.

The previous non-final Office Action alleges on page 9 that "Ukai discloses that the user preference conflicts with another user preference (**see Figure 3 and note that the two programs in table 300 are show at two overlapping/conflicting time periods in table entries 303**)" (emphasis in original). However, the Advisory Action on page 2 states that "Ukai clearly teaches determining a user preference **(view time period 404 in Figure 4)** for each of the plurality of viewing parameters **(each program name in Figure 4)**" (emphasis in original). As such, the Advisory Action appears to allege that view time period 404 corresponds to "a user preference". Applicant respectfully submits that *Ukai* does not teach or suggest that a view time period 404 "conflicts with another" view time period 404. Further, the table 300 is based on an EPG, and does not yet correspond to user preferences as derived from Figure 6 of *Ukai*. To allege otherwise is to say that everything in an EPG is a user preference, which obviates the need for the invention disclosed in *Ukai* and hence is an improper and unreasonable construction.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claim 6. Therefore, Applicant respectfully requests that the rejection of claim 6 be withdrawn.

Both the previous non-final Office Action (page 10) and, as expressed in the response prior to the previous non-final Office Action, the final Office Action (page 6) alleges that "Referring to claims 10-12, see the rejection of claims 1 and 9. Applicant respectfully submits that this vague rejection of Applicant's claim limitations is improper. In particular, the MPEP points out in § 707.07(d) under "Improperly Expressed Rejections" that:

> A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

Applicant submits that the rejection of claims 1 and 9 is not equally applicable to claims 10-12 because each claim contains different features. Specifically, Applicant's claims 10-12 provide as follows (emphasis added):

10.   The method of claim 9, where *the preference adaptive mode is activated via a switch located on a remote control device*.

11.   The method of claim 1, where *user preference is determined based on user input*.

12.   The method of claim 11, where *the user input indicates a preference for a viewing parameter*.

Applicant respectfully submits that the features recited and emphasized above in claims 10-12 are not included in claims 1 and 9. As such, the previous and present non-final Office Actions and final Office Actions both fail to present a *prima facie* case of obviousness against claims 10-12 for at least the reason that it fails to articulate a finding that the cited references include each element claimed. Accordingly, Applicant respectfully requests that the rejection of claims 10-12 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 13 and 14 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 13 and 14. Specifically, Applicant's claims 13 and 14 provide as follows (emphasis added):

13.   The method of claim 11, where *the user input indicates a preference against one or more of the plurality of viewing parameters*.

14.   The method of claim 11, where *the user input indicates* a preference for a first viewing parameter and *a preference against a second viewing parameter*, said first and second viewing parameters comprise the plurality of viewing parameters.

The previous non-final Office Action (page 10) and final Office Action (page 6) allege that "Ukai discloses that the user input indicates a preference against one or more of the plurality of viewing parameters (**see Figure 5 for the user viewing a program for a first time and second time, thereby showing entering a first time against a second time**)" (emphasis in original). However, the Advisory Action on page 2 states that "the view time period represents how interested the user [is] in the television program based on how long the user watches the television program." Thus, Applicant respectfully submits that "viewing a program" is not the

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same as "indicat[ing] a preference <u>against</u> one or more ... viewing parameters". Further,

Applicant respectfully submits that *Ukai* does not teach or suggest "indicat[ing] a preference

<u>against</u> one or more ... viewing parameters".

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of

the features recited in claims 13 and 14. Therefore, Applicant respectfully requests that the

rejections of claims 13 and 14 be withdrawn.

B.   Independent Claim 49

Claim 49 recites (emphasis added):

49. A system for providing television functionality comprising:
> logic for tracking a plurality of viewing parameters corresponding to
> services that are provided to a user;
> logic for determining a user preference for each of the plurality of
> viewing parameters;
> logic for tracking the user preference by assigning a score to each of
> the plurality of viewing parameters;
> ***logic for weighting the scores***;
> ***logic for determining an overall user preference score for the***
> ***plurality of tracked viewing parameters based on a linear***
> ***combination of the weighted scores associated with each of the***
> ***plurality of tracked viewing parameters for the user***;
> logic for receiving user input requesting television functionality; and
> logic for providing the user with a result that is responsive to the user
> input and to the overall user preference score.

Applicant respectfully submits that independent claim 49 is allowable for at least the reason that

a *prima face* case of obviousness has not been established based on *Ukai* in view of *Herz*. The

non-final Office Action (page 9) refers to the rejections to method claims 1-16, 20-24, and 27-45

for application to claims 49-65, 69-73, and 75-94. Applicant addresses the rejections below in

the context of the arguments made in the non-final Office Action to the method claims. The non-

final Office Action (page 4, emphasis in original) acknowledges that "Ukai fails to teach weighting

each of the viewing parameters and determining an overall user preference score for the plurality

of tracked viewing parameters based on a linear combination of <u>the weighted scores</u> associated

with each of the plurality of tracked viewing parameters for the user," yet alleges the following on

pages 4-5 (emphasis in original):

> Herz also discloses assigning scores to viewing parameters **(see Column
> 11, Line 30 through Column 15, Line 43 for creating and adjusting scores of
> characteristic values in customer profiles)** and weighting the scores **(see
> Column 10, Lines 39-40, Column 11, Lines 16-29 and Column 13, Lines 40-54).**
> Herz further teaches determining an overall user preference score for the
> plurality of tracked viewing parameters based on a linear combination of the
> weighted scores associated with each of the plurality of tracked viewing parameters
> for the user **(see Column 19, Line 5 through Column 21, Line 62 for using the
> weighted scores to determine a overall user preference score for the plurality
> of tracked viewing parameters based on a linear combination of the weighted
> scores in the customer profiles associated with each of the tracked
> characteristics for the user).** *The Examiner further notes Column 29, Line 29
> through Column 34, Line 11 for how customer profile characteristics values
> are continually updated based on the passive viewing of television program
> by a user, which includes additionally weighting the scores.*

Applicant respectfully disagrees. From the above, it appears that the Office alleges that the

"characteristics" equate to the claimed *viewing parameters*. Assuming *arguendo* that alleged

equivalence to be valid, it remains a bit unclear what is intended as the scores. The reason for the

unclarity is that the citations to *Herz* referenced above describe both cv and cp values. However,

cv is described in col. 10, line 33 of *Herz* as the customer's rating of a characteristics, and explains

in lines 47-58 of col. 10 (*Herz*) that the value or, apparently, alleged "score" of cv equates to the

accepted or preferred level for characteristic k. The above-citations particularly point to col. 10,

lines 48-49 of *Herz* (among other sections for weighting), where weighting involves the customer's

weight, wv, of a characteristic, and cp, which is described in col. 10, line 39 of *Herz* as the objective

weighting of program j for characteristic k. For the sake of advancing a discussion on the merits, it

is assumed *arguendo* that the value of cv is intended as an equivalent to the claimed *score*, and

that w is intended as an equivalent to the claimed *weighting* of the intended score. Wv is

described in col. 11, lines 15-17 of *Herz* as illustrating the importance of characteristic k to the

customer. So, it appears that the weighting and cv values are intended to enable (through

inclusion in the agreement scalar) the system in *Herz* to determine what characteristics are

important and acceptable to a user and hence facilitate the decision as to which program to include in a virtual channel (see, for example, column 9, lines 30-52, *Herz*). In other words, without using another methodology, such as duration of viewing (e.g., *Ukai*), as a method to determine importance of characteristics to the customer, the Cv and weighting values appear to be critical in *Herz* to establishing relevance and importance. On the other hand, *Ukai* enables the determination of which programs are preferred based on amount of time of viewing (duration) and the consequential generation of scores based on the duration of viewing (e.g., to establish the program view measure, which is used as a basis for all further calculations to result in a value in the database 300 (see, element 313, Figure 3 of *Ukai* and the previous response discussion). Weighting is shown in Figure 7 of *Ukai* for only one (element 703) of the plural characteristics that go into the final preference tally (total view score, 714, Figure 7, *Ukai*), suggesting less importance to the overall score than that which is attributed to weighting in *Herz*. Indeed, there exists no explanation as to the purpose of the weighting in *Ukai*, also suggesting a less significant role in the overall determination of preference measures, and more importantly, a fundamentally different methodology as explained further below.

Continuing, columns 19-21 of *Herz* illustrate an example of customer and content profiles, and the calculation of an agreement scalar between a given customer and program and ultimately a final agreement matrix. From col. 21, lines 50-52 of *Herz*, there appears to be a formula that involves a summation of weighting values multiplied respectively by the difference between cv and cp for each of the plural characteristics. Col. 10, lines 34-56 of *Herz* notes that an agreement scalar represents the similarity between the vector customer profile corresponding to cv and the vector program profile corresponding to cp, and col. 19, lines 5-10 of *Herz* indicates that the agreement scalars form an agreement matrix which provides measurements of the similarity between customer profiles and content profiles. A further explanation of an agreement matrix is provided in col. 19, lines 59-65 of *Herz*, which provides as follows:

In other words, perfect agreement will be met only when there is no difference between the customer profile and the content profile, or when there are differences only on certain characteristics and the customer ignores those characteristics. As a result, sorting all the programs in the ascending order of ac renders a recommendation list of programs for the customer.

Assuming *arguendo* the agreement matrix to be equivalent to the claimed **overall user preference score**, it is clear that the matrix provides an indication of similarity in characteristics between the customer profile and the content profile for a program, whereas *Ukai* uses duration of viewing as an underlying basis for a match between what characteristic is desired or preferred by a viewer and whether a given program has the desired characteristic. Perhaps the best that can be said of *Herz* is that the frequency of viewing may be used for determining relevance (e.g., in an update or feedback mode, such as described in col. 25, lines 38-40, col. 31, line 45, col. 33, line 62, col. 38, lines 58-60, *Herz*), which is clearly not the same as duration as described in *Ukai*.

In view of the above-discussion and these differences, one question to be asked in general is whether it is indeed obvious to combine *Ukai* and *Herz*, and in particular, whether one having ordinary skill in the art would be motivated to combine *Ukai* and *Herz*. The non-final Office Action (page 5) offers the following justification for combining *Ukai* and *Herz* (emphasis in original):

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the preference determination system, as taught by Ukai, using the agreement matrix calculation technique, as taught by Herz, for the purpose of providing video programs that have the most appeal to the customer **(see Column 9, Lines 50-51 of Herz).**

Applicant respectfully disagrees with this alleged motivation. For instance, as explained above, weighting appears more critical to *Herz* than to *Ukai*. Indeed, weighting in the manner described by *Herz* (e.g., for each and every characteristic) would fundamentally alter the operation of *Ukai*, which weights only one element (see Figure 7, element 703, *Ukai*) in its computation of a final or total view score. As set forth according to well-established Federal case law (and reproduced in MPEP 2143.01):

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Additionally, the system described in *Ukai* already chooses programs with the most appeal based on scoring and the underlying duration of viewing. It is not technically prudent to alter *Ukai* to achieve that which it already performs without the modification. Indeed, the emphasis on test groups and heavy customer interaction pertaining to the development of pre-configured customer and content profiles in *Herz* suggests an inferior process to the automation-focused system described in *Ukai*, further dissuading one having ordinary skill in the art to seek to modify *Ukai* in view of *Hertz*. For at least these reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been established, and respectfully requests that the rejection be withdrawn and claim 49 allowed.

Since independent claim 49 is allowable, Applicant respectfully submits that claims 50-65, 68-73 and 75-94, and 113-115 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988).

Applicant further notes that several dependent claim rejections had been rebutted in the previous response with no response or consideration of these arguments presented in the present non-final Office Action. Though acknowledging the changed grounds of rejection compared to the previous response, it is noted that the rejection for the below dependent claims remain un-altered from the previous rejection, hence suggesting no consideration. Accordingly, Applicant repeats and reproduces below (with minor changes to clarify which non-final Office Action is referenced) for consideration these rebuttal arguments and respectfully requests consideration of the same.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 51 and 52 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 51 and 52. Specifically, Applicant's claims 51 and 52 provide as follows (emphasis added):

51. The system of claim 49, where *the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user*.

52. The system of claim 49, where *the user preference is determined based on* a duration and *a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user*.

The previous non-final Office Action (page 8), like the final rejection (pages 4-5), alleges that "Ukai discloses that the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user (**see Figure 6 for determining a user preference 604 based on a number of programs 603 viewed**)" (emphasis in original). Applicant respectfully submits that "a frequency that a service … is presented to the user" is not the same as a number of programs viewed. Frequency implies a per-time period basis, which *Ukai* fails to teach.

Further, the previous non-final Office Action (page 9) refers to the rejection of claims 2 and 3 (e.g., claims 50-51) on page 8 for alleged support in *Ukai* for anticipation of the above-emphasized claim features. The rejection appears to allege that based on 404 (view time period) and 604 (specific view score), the above-emphasized features are shown. Applicant respectfully disagrees, and notes that *Ukai* does not teach or suggest that view time period 404 is determined based on "a frequency that a service … is presented to the user" as recited in claims 51 and 52. Again, frequency implies a per time period basis that is absent in *Ukai*.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 51 and 52. Therefore, Applicant respectfully requests that the rejections of claims 51 and 52 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claim 55 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claim 55. Specifically, Applicant's claim 55 provides as follows (emphasis added):

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55.   The system of claim 49, where **the user preference conflicts with another user preference**.

The previous non-final Office Action alleges on page 9 that "Ukai discloses that the user preference conflicts with another user preference (**see Figure 3 and note that the two programs in table 300 are show at two overlapping/conflicting time periods in table entries 303**)" (emphasis in original). However, the Advisory Action on page 2 states that "Ukai clearly teaches determining a user preference (**view time period 404 in Figure 4**) for each of the plurality of viewing parameters (**each program name in Figure 4**)" (emphasis in original). As such, the Advisory Action appears to allege that view time period 404 corresponds to "a user preference". Applicant respectfully submits that *Ukai* does not teach or suggest that a view time period 404 "conflicts with another" view time period 404. Further, the table 300 is based on an EPG, and does not yet correspond to user preferences as derived from Figure 6 of *Ukai*. To allege otherwise is to say that everything in an EPG is a user preference, which obviates the need for the invention disclosed in *Ukai* and hence is an improper and unreasonable construction.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claim 55. Therefore, Applicant respectfully requests that the rejection of claim 55 be withdrawn.

The previous non-final Office Action does not adequately address the features of claims 59-61, nor does the action previous to the same. The MPEP points out in § 707.07(d) under "Improperly Expressed Rejections" that:

> A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

Applicant submits that the rejection of claims 49 and 58 (e.g., 1 and 9 for the corresponding method claim set features) is not equally applicable to claims 59-61 because each claim contains different features. Specifically, Applicant's claims 59-61 provide as follows (emphasis added):

59.   The system of claim 58, where *the preference adaptive mode is activated via a switch located on a remote control device*.

60.   The system of claim 49, where *user preference is determined based on user input*.

61.   The system of claim 60, where *the user input indicates a preference for one or more of the plurality of viewing parameters*.

Applicant respectfully submits that the features recited and emphasized above in claims 59-61 are not included in claims 49 and 58. As such, the final Office Action fails to present a *prima facie* case of obviousness against claims 59-61 for at least the reason that it fails to articulate a finding that the cited references include each element claimed.   Accordingly, Applicant respectfully requests that the rejection of claims 59-61 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 62 and 63 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 62 and 63. Specifically, Applicant's claims 62 and 63 provide as follows (emphasis added):

62.   The system of claim 60, where *the user input indicates a preference against one or more of the plurality of viewing parameters*.

63.   The system of claim 60, where *the user input indicates* a preference for a first viewing parameter and *a preference against a second viewing parameter*, said first and second viewing- parameters comprise the plurality of viewing parameters.

The previous non-final Office Action (page 10) and final Office Action (page 6) alleges that "Ukai discloses that the user input indicates a preference against one or more of the plurality of viewing parameters (**see Figure 5 for the user viewing a program for a first time and second time, thereby showing entering a first time against a second time**)" (emphasis in original). However, the Advisory Action on page 2 states that "the view time period represents how interested the user [is] in the television program based on how long the user watches the television program." Thus, Applicant respectfully submits that "viewing a program" is not the same as "indicat[ing] a preference <u>against</u> one or more ... viewing parameters". Further,

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Applicant respectfully submits that *Ukai* does not teach or suggest "indicat[ing] a preference against one or more ... viewing parameters".

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 62 and 63. Therefore, Applicant respectfully requests that the rejections of claims 62 and 63 be withdrawn.

2.   Claims 25 and 74 - 35 U.S.C. § 103(a) - *Ukai* and *Alexander*

As acknowledged on page 4 of the non-final Office Action, *Ukai* is deficient in teaching the above-emphasized features pertaining to independent claims 1 (and 49 by virtue of reference to the claim 1 rejection for claim 49). It is respectfully submitted that the deficiency is not remedied by *Alexander* (nor alleged in the non-final Office Action of remedying the independent claim deficiencies). For at least the reason that *Ukai* in view of *Alexander* does not disclose, teach, or suggest the above-emphasized features of claims 1 and 49, dependent claims 25 and 74 are allowable as a matter of law. Accordingly, Applicant respectfully requests that the rejection be withdrawn and claims 25 and 74 be allowed.

3.   Claims 46-48 and 95-97 - 35 U.S.C. § 103(a) - *Ukai* and *Block*

With regard to claims 46-48, and as acknowledged on page 4 of the non-final Office Action, *Ukai* is deficient in teaching the above-emphasized features pertaining to independent claims 1 (and 49 by virtue of reference to the claim 1 rejection for claim 49). It is respectfully submitted that the deficiency is not remedied by *Block*. Because independent claim 1 is allowable over *Ukai* in view of *Block*, Applicant respectfully submits that claims 46-48 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully submits (as submitted in the previous response and un-addressed in the present non-final

Office Action) that a *prima facie* case of obviousness against claims 46-48 has not been presented. Specifically, MPEP § 2143.03 states:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In the present case, Applicant's claims 46-48 provide as follows (emphasis added):

46.   The method of claim 45, where **the result comprises not tuning to the user identified television service**.

47.   The method of claim 46, where **the result comprises prompting a user to provide additional input**.

48.   The method of claim 47, where **the additional input comprises a personal identification number (PIN)**.

While the non-final Office Action acknowledges on page 11 that "Ukai ... fails to teach a conditional access system that will not tune to a program selection unless a user enters his/her PIN/password", neither the final Office Action, the Advisory Action, nor the previous or present non-final Office Action even alleges that the features recited and emphasized above in claims 46-48 are disclosed or suggested by any of the cited references. Applicant has emphasized this omission in the prior response. Thus, for at least the reason that the Office Actions fail to articulate a finding that the cited references include each element claimed, Applicant respectfully requests that the rejection of claims 46-48 be withdrawn.

With regard to claims 95-97, the non-final Office Action (page 11) refers to the rejection of claims 46-48. To the extent there is overlap in claim features, for similar reasons presented above in association with claims 46-48, Applicant respectfully submits that claims 95-97 are allowable over *Ukai* in view of *Block* and respectfully requests that the rejection be withdrawn

II.   New Claim

As identified above, claim 116 has been added into the application through this Response. Applicant respectfully submits that claim 116 is allowable over the cited art of record for at least the reason that the cited art of record does not disclose, teach, or suggest at least "weighting exclusively the scores" and "determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user," and therefore, respectfully requests that this claim be held to be allowable.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-16, 20-25, 27-65, 69-97, and 112-116 be allowed to issue. Any statements in the non-final Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all allegations of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the final Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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